



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of Jiri Jekerle et al

Serial No. 10/565,305

Examiner: Leonard R. Leo

Filing Date: 01/19/2007

Group Art Unit: 3744

For: Tube Bundle Heat Exchanger

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICIAL ACTION

In response to the Office Action mailed September 16, 2009, Applicants provisionally elect the invention of Group I, in the event that a claim generic to both Group I and Group II is not allowed. Original claims 13-16 are readable upon the elected invention. Claims 12 and 18-23 are generic to both Groups.

The Applicants make such election with traverse on the basis that the Office Action of September 16, 2009 fails to state a reasoned explanation as to why the two species identified therein "are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." The Office Action alleges that "the species lack the same or corresponding special technical features for the following reasons: the mutually exclusive species are special technical features." However, the Office Action does not state what these "special technical features" are or how they are "mutually exclusive". The Applicants respectfully submit that merely "deeming" two embodiments of the subject application to lack unity is insufficient to support a restriction requirement.

The Board of Patent Appeals and Interferences has held that "deeming [a combination obvious] does not discharge him from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of

obviousness." Ex parte Stern, 13 USPQ2d 1379, 1381 (B. Pat. App. & Int. 1989). While this holding is not directly on point, it does establish the rule that an Office Action must provide facts and a reasoned argument supporting any allegations contained therein.

Respectfully submitted,

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